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10/498,074	06/09/2004	Kornelis Overkempe	PST6344PIUS/2183	3095
27624	7590	02/14/2013	EXAMINER	
AKZO NOBEL INC. LEGAL & IP 120 WHITE PLAINS ROAD, SUITE 300 TARRYTOWN, NY 10591			ANTHONY, JOSEPH DAVID	
			ART UNIT	PAPER NUMBER
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL
BOARD

Ex parte KORNELIS OVERKEMPE, WILLIAM JOHN ERNEST PARR,
and JOHANNA CHRISTINA SPEELMAN

Appeal 2011-013396
Application 10/498,074
Technology Center 1700

Before TERRY J. OWENS, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

PER CURIAM.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejections of claims 1, 3, 4, 8-10, and 22 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Hummel (US 3,029,125 issued Apr. 10, 1962), and of claims 1, 3, 4, 6-10, 14, 16, 17, and 19-22 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over De Groot (US 2,290,411 issued July 21, 1942).¹

For each rejection, Appellants only present arguments directed to the features of the independent claims 1 and 14, respectively drawn to a corrosion inhibiting composition and a method of inhibiting corrosion (App. Br. 8-14; *see* Claims Appendix filed as Supplemental Appeal Brief on Jan. 4, 2011 for a copy of claims 1 and 14).

Upon consideration of the evidence on this record and each of Appellants' contentions, we find that the preponderance of evidence on this record supports the Examiner's conclusion that the subject matter of Appellants' claims 1 and 14 is unpatentable. We sustain the above rejections based on the findings of fact, conclusions of law, and rebuttals to arguments expressed by the Examiner in the Answer.

We add the following for emphasis.

“Many of appellant's arguments fail from the outset because, . . . they are not based on limitations appearing in the claims” *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Appellants' argument that Hummel teaches the use of fully ethoxylated amine products as well as partially ethoxylated

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amine products versus the instant composition which contains only partially ethoxylated amines (Reply Br. 2; App. Br. 8) is unavailing since claim 1 and claim 14 are both open-ended and permit fully ethoxylated amine compounds (*see also, e.g.,* Ans. 3, 9).

Appellants' argument that De Groote fails to explicitly teach the use of its composition as a corrosion inhibiting composition is unpersuasive for reasons well stated by the Examiner (*e.g.,* Ans. 10-13). It is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed by the prior art, the burden is on the applicant to prove that the prior art product does not necessarily or inherently possess characteristics attributed to the claimed product, and that it is of no moment whether the rejection is based on § 102 or § 103 since the burden on the applicant is the same. *In re Spada*, 911 F.2d 705, 708 (Fed Cir. 1990); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977); *cf. In re Kao*, 639 F.3d 1057, 1070 (Fed. Cir. 2011) ("Maloney's express teachings render the claimed controlled release oxymorphone formulation obvious, and the claimed 'food effect' adds nothing of patentable consequence."); *In re Kubin*, 561 F.3d 1351, 1357 (Fed. Cir. 2009) (stating "[e]ven if no prior art of record explicitly discusses the [limitation], [applicant's] application itself instructs that [the limitation] is not an additional requirement imposed by the claims on the [claimed invention], but rather a property necessarily present in [the claimed invention]"); *see also King Pharms., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1275-76 (Fed. Cir. 2010) (stating that "merely discovering and claiming a new benefit of an old process cannot render the process again patentable" (citations omitted)).

The decision of the Examiner is affirmed.

Appeal 2011-013396
Application 10/498,074

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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